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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,502	02/16/2006	Yutaka Hanazono	1422- 0708PUS1	9981
2292 7590 03/24/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER CROUCH, DEBORAH				
ART UNIT 1632		PAPER NUMBER		
NOTIFICATION DATE 03/24/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/568,502

Applicant(s)

HANAZONO ET AL.

Examiner

Deborah Crouch, Ph.D.

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 2/16/06 5/16/06 4/30/07
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

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Claims 1-6 are pending.

The IDS's filed February 16, 2006 and May 16, 2006 are the same. The IDS filed February 16, 2006 has not been considered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimizu et al. (1996) Blood, Vol. 10, pp. 3688-3692.

Shimizu teaches human hematopoietic cells expanded in sheep fetuses (page 3689, col. 1, parag. 2). While the hematopoietic cells of claim 5 are stated to be produced by expansion of hematopoietic cells in a sheep fetus, there are no teachings in the specification that the resulting cells are structurally or functionally different from those of Sutherland. Thus, the method does not affect the product. An old product produced by a new method is not patentable unless method provides a new property to the product. Thus, Shimizu anticipates the claimed invention.

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product

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does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

"The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In *re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In *re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

"Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product (*In re Ludtke*). Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. In *re Best, Bolton, and Shaw*, 195 USPQ 430, 433 (CCPA 1977) citing *In re Brown*, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972))."

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In *re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not

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necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971), *Northam Warren Corp. v. D. F. Newfield Co.*, 7 F. Supp. 773, 22 USPQ 313 (E.D.N.Y. 1934.) See MPEP 2113 and MPEP 2112.01.

See MPEP 2112, Product-By-Process.

Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zanjani et al. (1996) *Internatl. J. Hematol.*, vol. 63, pp. 179-192 in view of Li et al. (2001) *Blood*, Vol. 98, pp. 335-342 and Sone et al. (April 2003), *Circulation*, Vol. 107, pp. 2085-2088 and further in view of Hamaguchi et al. (1999) *Blood*, Vol. 93, pp. 1549-1556.

Zanjani teaches the engraftment of human hematopoietic cells in fetal sheep by administering the human cells to the sheep fetus in utero to expand the cells (page 181, col. 2, parag. 1, lines 16-22). The engrafted sheep fetus is carried to term, whereby human IL-3, GM-CSF or c-Kit ligand were administered to the chimeric sheep, resulting in a significant increase human hematopoietic cells in the bone marrow of the sheep (page 184, col. 1, lines 3-11 and page 185, Table 4). The metaphase analysis discussed in Table 4 indicates separation of the human cells from the sheep. The increased human hematopoietic cell component in sheep bone marrow provides motivation to employ the method of Zanjani to expand human hematopoietic stem cells in the chimeric sheep model.

Li teaches the differentiation of primate ES cells into hematopoietic cells by culturing the ES cells on S17 bone marrow stromal cells in a media comprising BMP-4, whereby the number of expandable cultures increase 18 fold over cultures lacking BMP-4 (page 337, col. 2, parag. 2, line 3 to page 338, col. 1, line 6). Thus, motivation is clearly present for the differentiation of primate ES cells in the presence of BMP-4.

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Sone teaches the differentiation of primate ES cells when cultured on OP9 bone marrow stromal cells (page 2086, col. 1, parag. 2, lines 1-4). Hamaguchi provides specific motivation for co-culture with OP9 stromal cells as they M-CSF and thus are preferable because they do not induce macrophage production which in turn damages stromal cells (page 1553, col. 1-2, bridg. parag.).

Therefore at the time of the instant invention, it would have been obvious to the ordinary artisan to modify the method of Zanjani by administering primate/monkey/human hematopoietic cells differentiated in vitro by the method of Li and Sone in view of Hamaguchi. The combination of art provides sufficient motivation to combine the art to expand, as taught by Zanjani, the in vitro produced hematopoietic cells given the above cited motivation.

The combination of prior art cited above in all rejections under 35 U.S.C. 103 satisfies the factual inquiries as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Once this has been accomplished the holdings in KSR can be applied (*KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007): "Exemplary rationales that may support a conclusion of obviousness include: (A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation

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in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.” In the present situation, rationales A, B, E and F are applicable. The claimed method was known in the art at the time of filing as indicated by Zanjani, Li, Sone and Hamaguchi. Thus, the teachings of the cited prior art in the obviousness rejection above provide the requisite teachings and motivations with a clear, reasonable expectation. The cited prior art meets the criteria set forth in both Graham and KSR.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 571-272-0727. The examiner can normally be reached on M-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Crouch, Ph.D./
Primary Examiner, Art Unit 1632

March 27, 2008